

**REMARKS**

In accordance with the foregoing, claims 1, 15, 22, and 34 are amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 11, 15, 20, 22, 27 and 34-37 are pending and under consideration. Reconsideration is respectfully requested.

**Entry of Response under 37 C.F.R. §1.116**

Claim 1 is amended herein to correct a formality and replace the phrase "second display information comprising about" with the phrase --second display information comprising information about--. Claim 34 is amended to correct a formality and replace a comma at the end of the claim with a period.

Claim 1 is amended to correct formalities and replace the phrase "information indicating selecting" with the phrase "information indicating selection," and replace the phrase "one member themselves" with the phrase "one member himself or herself." Claims 15 and 22 are similarly amended.

Applicants request entry of this Rule 116 Response and Request for Reconsideration because it is believed that the amendments of claims 1, 15, 22, and 34 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised and do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised. As set forth in MPEP §714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis). The MPEP further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**Items 2-8: Rejection Of claims 1, 15, 20, 22, 27 and 34-37 under 35 U.S.C. §103(a) as being obvious over Namikata et al. (U.S.P. 5,949,414)**

In items 2-8 of the Office Action, the Examiner rejects claims 1, 15, 20, 22, 27 and 34-37 under 35 U.S.C. §103(a) as being obvious over Namikata. The rejection is traversed.

Independent claim 22 recites an information providing method including "transmitting a web page providing first display information to a terminal of one registered member . . . a first image to identify said one member, and a plurality of second images to identify other registered members, wherein each of the other registered members belongs to a same genre as said one member; receiving, from said terminal of said one member, information indicating selection of an image of a selected member from said first display information; transmitting a member web page

of said selected member to said terminal of said one member; if said selected member is one of the other members, forming second display information comprising information about said one of the other members and prompting the one member to input a comment to said one of the other members; and if said selected member is said one member himself or herself, forming second display information prompting said one member to request a comment from an expert in said genre (emphasis added)." Independent claims 1 and 15 have similar recitations.

Applicants submit that Namikata does not teach or suggest such method "where a selected member is said one member himself or herself, forming second display information prompting said one member to request a comment from an expert in said genre."

The Examiner asserts member icon 3-8 for user 1 taught by Namikata teaches the recited "a first image to identify said one member," the member icons 3-8 for other users taught by Namikata teach the recited "a plurality of second images to identify other registered members, wherein each of the other members belongs to a same genre as said one member," and the side conversation member panel 3-7 in Fig. 3A and col. 5, lines 40-42 taught by Namikata teach the recited "when said selected member is one of the other members, forming second display information and prompting the one member to input a comment to said one of the other members." (Action at page 2, line 12 page 3, line 3).

Applicants submit that Namikata does not teach or suggest a person, who is not a conference member whose icons are displayed in conference member panel 3-6. Further, Namikata does not teach or suggest inviting a person, who is not a conference member, to join a side conversation.

In item 6 of the Office Action, the Examiner asserts:

The examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP §2111.01.111). The reference teaches that since all the users belong to the same meeting, "Expert" is interpreted as anyone from whom a knowledgeable opinion is sought.

The Examiner also asserts that "The invitation to join a side conversation" in Namikata reads on "transmitting a request for a comment from the one member to the expert."

However, Applicants respectfully as clearly described in the specification:

The comment storage unit 99 stores comments for each member so as to identify that a person who has registered the comment is an expert or another member.

(Emphasis added, See, page 13, lines 12-15 of the specification).

That is, the term "expert" according to aspects of the present invention, as recited by the claims is clearly described so as to not include "the other members".

Thus, Applicants submit that the Examiner's interpretation of the term "expert" is overly broad, and that as understood by one of ordinary skill in the art it would be unreasonable to assert that the "expert" as recited in claims 1, 15, and 22 includes "the other members," as the Examiner incorrectly interprets.

Moreover, assuming that the recited "one member" is taught by Namikata "user 1," Namikata teaches a selection of "a member icon" of a conference member as "a side conversation-destination user", who may correspond *arguendo* to the "other members" as recited by claims 1, 15, and 22.

Applicants submit that one of ordinary skill in the art would find it unreasonable that a person selects himself or herself to talk to in a side conversation. That is, Applicants respectfully submit that it is an unreasonable and an overly-broad interpretation that Namikata's "user 1" invites the "user 1" himself/herself as "a side-conversation-destination user".

Accordingly in a reasonable interpretation, Namikata, instead, teaches that a member icon must be that of a conference member except the "user 1." Applicants submit there is no teaching in Namikata that the "user 1" selects himself/herself.

Therefore, Namikata does not teaches or suggest, "said selected member is said one member himself or herself," as recited by claims 1, 15, and 22.

Furthermore, since Namikata does not disclose or suggest that the "user 1" invites a person, who is not a conference member, to join a side conversation, Namikata does not teach or suggest that "if said selected member is said one member himself or herself, forming second display information prompting said one member to request a comment from an expert in said genre." The Examiner asserts that:

The invitation to join a side conversation (col. 5 lines 36-41) reads on "transmitting a request for a comment from the one member [e.g., user 1] to the expert [user 3 in Fig. 3A].

(Action at page 4, lines 1-2).

Even *arguendo* assuming that Namikata's teaching of a user selecting their own icon teaches the recited "if said selected member is said one member himself or herself" and that Namikata's teaching of an invitation to join a side conversation teaches the recited "to request a

comment from an expert in said genre," Namikata does not teach "if said selected member is said one member himself or herself, forming second display information prompting said one member to request a comment from an expert in said genre (emphasis added)," as recited by claim 1, for example.

By contrast, Namikata teaches:

When a user wants to start side conversation, the user selects a member icon as a side-conversation-destination user from the conference member panel 3-6, then drags the member icon 3-8 to a side conversation member panel 3-7 and drops the member icon. Then, the user clicks a side conversation start button 3-10. Side conversation is started upon agreement of the destination user. When the user wants to end the side conversation, the user clicks a side conversation end button 3-9. If the destination user does not agree to start/end side conversation, a message shown in FIG. 4A is displayed in a message panel 3-21.

(column 5, lines 35-46).

That is, Namikata clearly indicates that the side conversation is merely between a first user and another destination user, and not any type of comment to the user, himself or herself.

#### **Summary**

Since features recited by independent claims 1, 15, and 22 (and respective dependent claims 11, 20, 27, and 34-37) are not taught by the cited art, alone or in combination, the rejection should be withdrawn and claims allowed.

#### **Item 9: Possibility of Allowable Subject Matter And Request For Interview**

In item 9 of the Office Action, entitled Possibility of Allowable Subject Matter, the Examiner asserts:

Namikata et al. does not teach or suggest that the images are arranged in a tree format, which is supported by Fig. 1 of the application. Hence the instant rejection could be overcome by appropriate addition of this limitation, e.g., by amending line 8 of claim 1 to read, "a plurality of second images in a tree-like arrangement to identify other registered members, wherein" and similarly amending the other independent claims.

(Action at page 4, lines 8-14).

Applicants appreciate the thoughtful Examiner's suggestions. However, the Applicants believe that the claims as recited herein patentably distinguish from Namikata for the reasons discussed above.

However, if the case is not allowed, Applicants respectfully request an interview the Examiner to discuss the claim recitations.

#### **CONCLUSION**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all

pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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